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*Elizabeth A. Middleton* 6/5/2002

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Rajagopalan et al.  
Application No.: 09/898,885  
Filed: July 3, 2001  
Title: **Dye-Azide Compounds for Dual Phototherapy**  
Art Unit: 1614  
Examiner: M. Ceperley  
Atty. Docket No.: MRD-62

Cincinnati, OH 45202

June 5, 2002

Commissioner for Patents  
Washington, DC 20231

Sir:

### RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action faxed on May 5, 2002 in the above-referenced application, applicants elect with traverse Group 1 (claims 1-11), drawn to compounds of the Formula E--L--DYE--X--N<sub>3</sub> and uses thereof wherein E is hydrogen and the dye is a cyanine.

However, applicants respectfully assert that such a restriction is improper. At the outset, applicants note that all the claims are directed to the structure designated as the formula E--L--DYE--X--N<sub>3</sub>. More, specifically, claims 1-11 recite a compound, and claims 12-30, 31-33, 34-36, and 37-39 recite a method of performing a

procedure by administering a compound, such as that of the above formula. Applicants now provide the following analysis in support of their assertion.

First, the Examiner's restriction forces applicants to fragment the invention they claimed within a single claim. Under *In re Weber, Soder, & Boksay*, 198 U.S.P.Q. 328, 331-32 (C.C.P.A. 1978) (copy attached) this is not permitted.

The invention in *Weber* related to cyclic diamine derivatives possessing a common psychotherapeutic property and was identified by a single generic formula expressed in Markush format. The instant invention relates to organic azides possessing a common physiological property and the derivatives are identified by a single generic formula (E--L--DYE--X--N<sub>3</sub>) expressed in Markush format.

In *Weber*, the court viewed the Examiner's restriction as tantamount to a refusal to examine. It held that the United States Patent and Trademark Office authority to restrict between claims of an application reciting one or more independent and distinct inventions, but does not have the authority to require an applicant to divide up a single claim and present it in different applications; this would allow an Examiner, rather than an applicant, to define an invention in violation of 35 U.S.C. §121, ¶2 ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention", emphasis added). *Weber* at 332. While recognizing the need for efficiency in limiting each application to one invention, the court stated that

...in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights [of the applicant] are paramount.

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Second, §803.02 of the MPEP states that if the claims have unity of invention, it is improper to refuse to examine "that which applicants regard as their invention". Unity of invention exists where compounds included within a Markush group share a common utility and share a substantial structural feature as being essential to that utility.

With regard to the instant application, all the claimed compounds share an organic azide structure as shown in the above formula, and have the same utility as receptor-targeted azide derivatives and their bioconjugates for phototherapy of tumors and other lesions.

For the reasons discussed, applicants respectfully request that the Examiner reconsider the restriction requirement.

Applicants know of no fee due with this submission. However, if any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account 23-3000.

Respectfully submitted,

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